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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,241	02/06/2004	Frederick Earl Boyer JR.	PC25654A	9112

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WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR, MI 48105

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,241

Applicant(s)

BOYER ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 16-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/04, 9/04, 2/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-39 are pending in the application.

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on April 21, 2006 is acknowledged.
2. Claims 16-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 21, 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-15 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:
 - a) Claims 1-11, 38 and 39 are vague and indefinite in that it is not known what is meant by the moiety heterocylco in the definition of B.
 - b) Claims 1-11, 38 and 39 are vague and indefinite in that it is not known what is meant by the moiety C(=O)-heteteroaryl in the definition of B.
 - c) Claims 1-, 38 and 39 are vague and indefinite in that it is not known what is meant by the second occurrence of aryl, heteroaryl, heterocyclo, OR₅,

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$\text{OC}(=\text{O})\text{R}_1$, NR_6R_7 , NHR_5 , $\text{N}(\text{C}=\text{O})\text{R}_5$, $\text{NH}(\text{C}=\text{O})\text{OR}_5$, NHSO_2R_5 and NHSO_2NR_5 in the definition of substitution of the het ring containing V and W.

- d) Claims 1-15, 38 and 39 are vague and indefinite in that it is not known what is meant by OH in the definition of substitution of the het ring containing V and W, which is embraced by OR_5 resulting in a double inclusion of the OH moiety.
- e) Claims 1-7, 9-14, 38 and 39 are vague and indefinite in that it is not known what is meant by the moiety $\text{C}=\text{C}-\text{R}_5$ in the definition of X, Y and Z which is not valence satisfied.
- f) Claim 2 is vague and indefinite in that it is not known what is meant by the second occurrence of the 1,2,3-oxadiazole moiety in the definition of the het ring containing V and W.
- g) Claim 2 recites the limitation " R_3 " in definition of the het ring containing V and W. There is insufficient antecedent basis for this limitation in the claim.
- h) Claims 2-5 and 11-13 are vague and indefinite in that it fails to end with a period indicating the end of the claim.
- i) Claims 3-5 and 11-13 are vague and indefinite in that it is not known what is meant by the period at the end of the first line of the claim.
- j) Claim 13 is vague and indefinite in that it is not known what is meant by the variable M, which is not defined.
- k) Claim 37 is vague and indefinite in that it is not known what is meant by methoxy in the nomenclature of the 5th species on page 318, lines 13-14.

- l) Claim 37 is vague and indefinite in that it is not known what is meant by trifluormethyl in the nomenclature of the 7th species on page 318, lines 19-20.
- m) Claim 37 is vague and indefinite in that it is not known what is meant by the second occurrence of the 11th species on page 321, lines 31-32, which also appears in lines 35-36 on page 321.
- n) Claim 37 is vague and indefinite in that it is not known what is meant by the second occurrence of the 4th species on page 323, lines 11-12, which also appears in lines 25-26 on page 322.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-9, 11-15, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartel et al., DE 199 01 306. Bartel teaches the compounds, compositions and method of use of the compounds of formula (I) where P is imidazo[2,1-a]-1,3,4,5-tetrahydrobenzoazepin-7-yl, E is N, F is C, D is C, A is NH, B is C(=O)Me as set forth in example 1.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-15 and 37-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-6, 20, 22, 23, 41, 42, 54, 78-83 of copending Application No. 10/646,440. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the compounds of formula I of the instant invention are embraced by the compounds, compositions and method of use of the compounds of formula III where B and R₂ together form a tricyclic heterocyclic ring.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Claim Objections

6. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be in the alternative. See MPEP § 608.01(n).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Brenda L. Coleman
Primary Examiner Art Unit 1624
July 3, 2006